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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,022	04/08/2004	Zipora Brown	1330.1022CC	7563
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER MERCHANT, SHAHID R	
			ART UNIT	PAPER NUMBER
			3694	
			MAIL DATE	DELIVERY MODE
			08/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,022

Applicant(s)

BROWN ET AL.

Examiner

Shahid R. Merchant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on July 9, 2007. Claims 1-16 are pending.

Response to Arguments

2. Applicant's arguments, see page 7, filed July 7, 2007, with respect to Abstract have been fully considered and are persuasive. The objection for the Abstract has been withdrawn.
3. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 and 6 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,910,021. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining debt to be referred for offset payment responsive to debt selection criteria, a payment to be referred for offset of a debt responsive to payment selection criteria, referring the payment to the offset payment system responsive to the determination, referring the debt to the offset payment system responsive to the determination. The differences between claim 1 of the '021 Patent

and claims 1 and 6 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

6. Claim 2 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,910,021. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: updating automatically, within the computer implemented accounts receivable and accounts payable systems, the payment and the debt records and updating the offset records in the offset payment system responsive to the payment. The differences between claim 1 of the '021 Patent and claim 2 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

7. Claim 3 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,910,021. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: wherein debt records comprise one of general ledger records, budget records, planning records, project management records and cost accounting records. The differences between claim 7 of the '021 Patent and claim 3 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

8. Claim 4 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,910,021. Although the conflicting claims are not identical, they are not patentably distinct from each other. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining, within a computer implemented accounts receivable financial management system, a payment to be referred for offset of a debt responsive to payment selection criteria and referring the payment to the offset payment system responsive to the determination. The differences between claim 6 of the '021 Patent and claim 4 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements

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perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

9. Claim 5 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,910,021. Although the conflicting claims are not identical, they are not patentably distinct from each other. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: updating automatically payment records, within the computer implemented accounts payable financial management system, responsive to the offset by the offset payment system. The differences between claim 6 of the '021 Patent and claim 5 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

10. Claim 7 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,532,450. Although the conflicting claims are not identical, they are not patentably distinct from each other. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining, within a computer implemented accounts receivable financial management system separate from the offset payment system, debt

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to be referred for offset payment responsive to debt selection criteria, referring the debt to the offset payment system responsive to the determination payment records responsive to the offset by the offset payment system; accepting a payment from a debtor; updating automatically, within the computer implemented accounts receivable and accounts payable financial management systems, the payment and the debt records and updating the offset records in the offset payment system responsive to the payment. The differences between claim 1 of the '021 Patent and claim 7 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

11. Claim 8 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,532,450. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining, within a computer implemented accounts receivable financial management system separate from the offset payment system, debt to be referred for offset payment responsive to debt selection criteria, referring the debt to the offset payment system responsive to the determination payment records responsive to the offset by the offset payment system; accepting a payment from a debtor; updating automatically, within the computer implemented

accounts receivable and accounts payable financial management systems, the payment and the debt records and updating the offset records in the offset payment system responsive to the payment. The differences between claim 1 of the '021 Patent and claim 8 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

12. Claim 9 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,532,450. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining, within a computer implemented accounts receivable financial management system separate from the offset payment system, debt to be referred for offset payment responsive to debt selection criteria, referring the debt to the offset payment system responsive to the determination; determining, within a computer implemented accounts payable financial management system separate from the accounts receivable system, a payment to be referred for offset of a debt responsive to payment selection criteria, referring the payment to the offset payment system responsive to the determination; updating automatically, within the computer implemented accounts receivable financial management system, debt records responsive to an offset by the offset payment system the debt records. The

differences between claim 2 of the '021 Patent and claim 9 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

13. Claim 10 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,532,450. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining, within a computer implemented accounts receivable financial management system separate from the offset payment system, debt to be referred for offset payment responsive to debt selection criteria and referring the debt to the offset payment system responsive to the determination. The differences between claim 1 of the '021 Patent and claim 7 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

14. Claim 11 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,910,021. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining debt to be referred for offset payment, determining, within a computer implemented accounts payable system separate from the accounts receivable system, a payment to be referred for offset and updating automatically, within the computer implemented accounts payable system, payment records responsive to the offset by the offset payment system; recording a payment from a debtor; updating automatically the payment and the debt records and updating the offset records in the offset payment system responsive to the payment. The differences between claim 1 of the '021 Patent and claim 11 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

15. Claim 12 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 6,910,021. Although the conflicting claims are not identical, they are not patentably distinct from each other. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining, within the computer implemented accounts receivable financial management system, debt to be referred for offset payment, determining, within the computer implemented accounts payable financial management

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system, a payment to be referred for offset of a debt, referring of the debt, by the computer implemented financial management system, to the offset payment system responsive to the determination, performing multiparty accounting functions allocating monies relative to multiple sources and multiple destinations within the accounts payable and accounts receivable financial management systems responsive to the referred debt. The differences between claim 23 of the '021 Patent and claim 12 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

16. Claim 13 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,910,021. Although the conflicting claims are not identical, they are not patentably distinct from each other. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: notifying a debtor of the referral and the offset. The differences between claim 1 of the '021 Patent and claim 13 of the instant application would have been obvious because the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

Claim Rejections - 35 USC § 112

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claim 7 recites the limitation "the debt record" in line 5. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 8 recites the limitation "the authorization" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 8 recites the limitation "the payment record" in line 5. There is insufficient antecedent basis for this limitation in the claim.

21. Claim 9 recites the limitation "the debt and payment records" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

Allowable Subject Matter

22. Claims 14-16 would be allowable if rewritten to overcome the Double Patenting rejection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

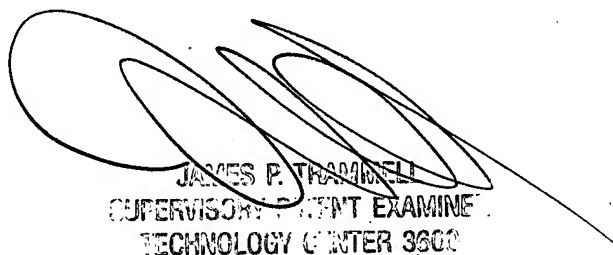
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid R. Merchant whose telephone number is 571-270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammel can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM


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